



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPEAL BRIEF FOR THE APPELLANT

Ex parte HAUMONT et al.

METHOD AND SYSTEM OF PROVIDING A SERVICE TO A SUBSCRIBER

Serial No. 09/748,505

Appeal No.:

Group Art Unit: 2683

Enclosed is a check in the amount of Six Hundred Twenty Dollars (\$620.00), which includes \$500.00 to cover the official fee for this Appeal Brief and \$120.00 to cover the extension of time fee. In the event that there may be any fees due with respect to the filing of this paper, please charge Deposit Account No. 50-2222.

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In re the Appellant:

HAUMONT et al.

Appeal No.:

Serial Number: 09/748,505

Group Art Unit: 2683

Filed: December 26, 2000

Examiner: Keith Ferguson

For: **METHOD AND SYSTEM OF PROVIDING A SERVICE TO A SUBSCRIBER**

BRIEF ON APPEAL

August 17, 2005

I. INTRODUCTION

This is an appeal from the final rejection set forth in an Official Action dated November 17, 2004, finally rejecting claims 29-39 and 41-56 in the subject patent application. Claims 29-31, 34, 41-44 and 48-54 stand rejected as being obvious over 35 U.S.C. 103(a) over US Patent No. 5,579,535 to Orlen et al. (Orlen), in view of US Patent No. 6,310,889 to Parsons et al. (Parsons), claim 32 stands rejected under 35 U.S.C. §103(a) as being obvious over Orlen and Parsons, and further in view of US Patent No. 5,905,777 to Foladare et al. (Foladare), claims 33, 35-38 and 45 stand rejected under 35 U.S.C. §103(a) as being obvious over Orlen, in view of Parsons and further in view of US Patent No. 5,555,446 to Jasinski (Jasinski), claim 39 stands rejected under 35 U.S.C. §103(a) as

being obvious over Orlen, in view of Parsons and Jasinski and further in view of Us Patent No. 6, 141, 558 to Chen (Chen), claims 46 and 47 stand rejected under 35 U.S.C. §103(a) as being obvious over Orlen, in view of Parsons and Jasinski and further in view of WO 98/21913 to Bhatia, and claims 55 and 56 stand rejected under 35 U.S.C. §103(a) as being obvious over Orlen, Parson and further in view of Bhatia. A Response under 37 CFR § 1.116 was timely filed on April 18, 2005. A Notice of Appeal was timely filed on May 17, 2005 with an appropriate petition for Extension of Time. This Appeal Brief is being timely filed.

II. REAL PARTY IN INTEREST

The real party in interest in this application is Nokia Networks Oy, of Espoo, Finland, by virtue of an Assignment which was submitted for recordation on April 6, 2001, and which was recorded at Reel 011690, Frame 0190, on April 4, 2001. It is noted that Nokia Networks Oy is wholly owned by Nokia Corporation, also of Finland.

III. STATEMENT OF RELATED APPEALS AND INTERFERENCES

There are no known related appeals and/or interferences which will directly effect or be directly effected by or have a bearing on the Board's decision in this appeal.

IV. STATUS OF CLAIMS

Claims 1-28 and 40 cancelled without prejudice. Claims 29-31, 34, 41-44 and 48-54 stand rejected as being obvious over 35 U.S.C. 103(a) over US Patent No. 5,579,535 to Orlen et al. (Orlen), in view of US Patent No. 6,310,889 to Parsons et al. (Parsons), claim 32 stands rejected under 35 U.S.C. §103(a) as being obvious over Orlen and Parsons, and further in view of US Patent No. 5,905,777 to Foladare et al. (Foladare), claims 33, 35-38 and 45 stand rejected under 35 U.S.C. §103(a) as being obvious over Orlen, in view of Parsons and further in view of US Patent No. 5,555,446 to Jasinski (Jasinski), claim 39 stands rejected under 35 U.S.C. §103(a) as being obvious over Orlen, in view of Parsons and Jasinski and further in view of US Patent No. 6,141,558 to Chen (Chen), claims 46 and 47 stand rejected under 35 U.S.C. §103(a) as being obvious over Orlen, in view of Parsons and Jasinski and further in view of WO 98/21913 to Bhatia, and claims 55 and 56 stand rejected under 35 U.S.C. §103(a) as being obvious over Orlen, Parsons and further in view of Bhatia. The PTO's rejection of claims 29-39 and 41-56 set forth in the Final Office Action dated November 17, 2004 is being appealed.

V. STATUS OF AMENDMENTS

Original claims 1-28 were cancelled, new claims 29-56 were submitted and claims 30-56 were amended in a Preliminary Amendment which was filed on December 26, 2000. Claims 29-56 were amended on October 31, 2003. Claim 40 was cancelled without

prejudice and claims 29, 30, 34, 35, 41, 42 and 48-52 were amended on July 29, 2004. No further amendments have been made, therefore, claims 29-39 and 41-56 are pending.

VI. SUMMARY OF THE INVENTION

The present invention relates to a method for providing a service to a subscriber in a network. As discussed on page 5 lines 6-13, according to an embodiment of the invention, the method includes providing network related information which is related to the subscriber. Further the method includes generating a service message on the basis of the provided network related information, and transmitting the service messenger to the subscriber. As described on page 6 lines 21-26, the network related information is provided to a service provider, the service message is a message generated by the service provider and is transmitted to all those subscribers for which the same network related information is provided to the service provider. Page 6 lines 29-33 further describes that the network related information of the subscriber is transmitted in a header of a packet transmitted by the mobile station of the subscriber.

Figure 1 illustrates an exemplary system for providing a service to a subscriber (mobile station 1) in a network. The system includes providing means 7 for providing network related information which is related to the subscriber and control means for controlling the provision of the network related information in dependence on a predetermined subscriber condition. As shown in Figure 1 and described on page 5 line 38-

page 6 line 7 of the specification, the providing means is arranged to provide the network related information to a service provider 5 connected to the network and the service provider 5 is arranged to generate a message on the basis of the network related information and the message being transmitted to said subscriber 1. As described on page 6 lines 29-33, the service message is transmitted to all those subscribers for which the same network related information is provided to the service provider when the network related information of the subscriber is transmitted in the header of a packet transmitted by the mobile station of the subscriber.

VII. ISSUES

The issues on appeal are whether the rejection of claims 29-39- 41-56 discussed above are in error.

VIII. GROUPING OF CLAIMS

Applicants respectfully submit that each of claims 1-39 and 41 -56 stands alone. In other words, each of the presently pending claims is separately patentable.

IX. APPELLANT'S ARGUMENTS

Applicants respectfully submit that each of pending claims 29-39 and 41-56, recites subject matter which is neither disclosed nor suggested by the cited and applied references.

The Final Office Action rejected claims 29-31, 34, 41-44, and 48-54 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,579,535 to Orlen et al. (Orlen),

in view of U.S. Patent No. 6,310,889 to Parsons et al. (Parsons).

The Final Office Action took the position that Orlen discloses all of the features recited in claim 29 and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Orlen with a network related information of the subscriber [that] is transmitted in a header of a packet transmitted by the mobile station of the subscriber in order for the base station of the network to check to see if portable telephone is authorized to receive the localized and positional information, as taught by Parsons. Applicants respectfully submit that claims 29-31, 34, 41-44, and 48-54 recite features that are neither disclosed nor suggested in the cited references.

Claim 29, upon which claims 30-39 and 41-47 depend, recites a method for providing a service to a subscriber in a network. The method includes providing network related information which is related to the subscriber, generating a service message on the basis of the provided network related information, and transmitting the service messenger to the subscriber. In the method, the network related information is provided to a service provider, the service message is a message generated by the service provider and is transmitted to all those subscribers for which the same network related information is provided to the service provider. Further in the method, the network related information of the subscriber is transmitted in a header of a packet transmitted by the mobile station of the subscriber.

Claim 48, upon which claims 49-56 depend, recites a system for providing a service

to a subscriber in a network. The system includes providing means for providing network related information which is related to the subscriber and control means for controlling the provision of the network related information in dependence on a predetermined subscriber condition. In the system, the providing means is arranged to provide the network related information for a service provider connected to the network and the service provider is arranged to generate a message on the basis of the network related information and the message being transmitted to said subscriber. Further in this system, the service message is transmitted to all those subscribers for which the same network related information is provided to the service provider when the network related information of the subscriber is transmitted in the header of a packet transmitted by the mobile station of the subscriber.

As will be discussed below, the cited combination fails to disclose or suggest the elements of any of the presently pending claims.

Orlen '535 discloses a personal communication system providing a supplemental information mode. More specifically, Orlen '535 discloses portable radiotelephone handsets and a system information data base for transmission to the telepoint base stations, which are equipped to provide the positional and localized information to requesting radiotelephone handsets, see column 3 lines 47-58. Orlen '535 also discloses that the information is relating or pertaining to the conduct of business, see Orlen *id.* Orlen '535 further discloses that the information is only delivered to the portable radio telephone upon request of the portable radio telephone. See Orlen, column 3 lines 59-65.

Further, it is admitted in the Final Action that Orlen does not disclose or suggest the feature of transmitting network related information of the subscriber in a header of a packet transmitted by the mobile station of the subscriber. It is asserted in the Final Action that Parsons makes up for this deficiency.

Parsons discloses a method of servicing data access requests from users. Parsons discloses recognizing a user's IP address, which is contained in the IP header of each IP packet.

The Applicants submit that the cited combination of references taken individually or in combination, do not teach or suggest the features recited in any of the pending claims. Claim 29, in part, recites providing a network related information which is related to said subscriber. Claim 48, in part, providing means for providing a network related information which is related to said subscriber.

The Applicants submit that the cited references taken either individually or in combination, do not disclose or suggest the feature of providing a network related information which is related to a subscriber, as recited in claims 29 and 48. As discussed above, Orlen merely discloses positional and localized information which are characterising for a business establishment, to requesting radiotelephone handsets, see column 3 lines 47-58. Further, the business establishments send information such as the establishment's name and location, marketing and advertisement information. See column 6 lines 58-64 of Orlen. The positional and localized information is related to the conduct

of business. It is alleged in the Advisory Action dated May 3, 2005 that this feature is disclosed in Orlen because “business establishments are a part of the network because the business information of the business establishment is sent through the network to a mobile station, therefore it is network related.” However, Orlen does not mention or suggest that the business establishments are in fact part of any network.

The Applicants submit that, in contrast, the network-related information recited in claims 29 and 48 at least in view of dependent claims 30 and 49, relates to at least one of an identity, a location, an address, and an operating state of a mobile station of the subscriber in a cellular network. It is further submitted that Parsons fails to mention or suggest this feature and thus does not cure the deficiencies of Orlen.

Further, claim 29 recites in part, generating a service message on the basis of the provided network related information. Similarly, claim 48 recites in part, that the service provider is arranged to generate a message on the basis of said network related information, the message being transmitted to the subscriber.

Applicants respectfully submit that one skilled in the art would recognize that since no network related information is provided as discussed above, the cited references taken individually or in combination, fail to disclose or suggest the feature of generating a service message based on the network related information, as recited in claims 29 and 48. Further, It is respectfully submitted that the expression "related information" is not taken into account in the Final Office Action which appears to construe the claim feature as "generate

a service message on the basis of said provided network". In particular, cited passages column 7, lines 63 to 65, and more precisely, column 7, line 50 to column 8, line 3 of Orlen pertain to the registration of business establishment related information within the network. Thus, no service message is generated, but merely the information which is later on to be transmitted in a service message is provided. However, even that information is not provided on the basis of provided network related information related to the subscriber, but based only on the information associated to a business establishment.

Further, claim 29 in part recites the feature of said network related information is provided for a service provider and claim 48 in part recites a providing means is arranged to provide said network related information for a service provider connected to said network. Applicants respectfully submit that the cited references taken individually or in combination fail to disclose or suggest this feature. The feature of "providing network related information for a service provider" should be interpreted as "providing network related information to a service provider," especially in light of the feature: ". . . service message is transmitted to all those subscribers for which the same network related information is provided to the service provider" (underline added) that is recited in claims 29 and 48. Orlen merely discloses that business establishment related information is provided. Furthermore, such information in Orlen is delivered to a base station and not provided to a service provider as recited in claims 29 and 48. A service provider is an entity and/or organisation different from the network operator and/or the network. Rather,

according to Orlen, the business establishment related information is provided to a base station and/or a plurality of base stations. Thus, the information is distributed within the network infrastructure, but not provided for a service provider. Apart from this, the difference remains that what is distributed is not network related information relating to the subscriber but information referring to a business establishment.

The Advisory Action dated May 3, 2005 admits that this feature is not disclosed or taught in Orlen. Orlen merely discloses that the business related information is delivered to a telepoint base station and is not provided to a service provider, see column 7, lines 63-65 of Orlen. Thus, Orlen does not disclose that the network related information is transmitted to a service provider, as recited in claims 29 and 48. The Applicants respectfully submit that a service provider is not analogous to a base station in the present case. Further, Parsons fails to mention or suggest this feature and thus, fails to cure the deficiencies of Orlen.

Claim 29 in part recites the feature that the service message is a message generated by the service provider and claim 48 in part recites the service provider is arranged to generate a message on the basis of the network related information. The Applicants respectfully submit that the cited references taken individually or in combination fail to disclose or suggest this feature. The cited passage of Orlen column 6, line 50 – column 7 line 18 does not show that a service message is generated, because it is not transmitted to the subscriber. Rather, some service information (which might later on be used in a message to be sent to the subscriber) is generated. The generation, however, is not

performed by a service provider, but by a business establishment and it is generated (stored) at the telepoint base station, as stated by Orlen, column 8, line 15-16. Further the Final Office Action alleges that the service provider corresponds to the business establishment. However, apparently, the Office Action appears to vacillate between different meanings of the expressions from claim feature to claim feature. Namely, the service provider is analogous to the base station, while in the present discussion for example, it is alleged that the service provider corresponds to the business establishment.

Still further, claim 29 in part, recites the feature of transmitting the service message to the subscriber and claim 48 in part recites the [service] message being transmitted to the subscriber. Applicants respectfully submit that the cited references taken individually or in combination fail to disclose or suggest this feature. Orlen at column 7, lines 63-65 specifies that a transmission described therein is directed to a telepoint base station. Even if only for the sake of argument should that transmission be regarded as a service message the service message is not directed to the subscriber, but to the base station. It is respectfully submitted that a subscriber is not analogous to a base station in the present case. In contrast, according to the present invention, the subscriber places/provides information to a service provider. The information the subscriber provides is subscriber related and related to the subscriber's properties within the network (see for example claim 30). Insofar, the network related information related to the subscriber is substantially dynamic. In Orlen, the transmission is dependent on a request by the mobile station. See column 6, line 50 – column 7, line 16.

Transmitting some information on request, is, however, not comparable as corresponding to being dependent on the same network related information. It is arguable that a mobile station being present in the coverage of a cell relates to network related information for the mobile station, which is the same for all mobile stations present within the coverage of the cell. However, even if all mobile stations are present in the coverage of the same cell, not all mobile stations need to receive the information unless they request it (according to Orlen). Still further, if they should request for the information, all requesting mobile stations receive the same information from the base station and the subscriber then selects from the information (see Orlen, column 9, lines 3 to 23). Thus, the information the subscribers within the network receive is base station specific and depends on the base station in the coverage thereof they are currently located. In contrast, according to the present invention (see page 4, lines 1 to 10 of the specification), user specific information are contained in the service message transmitted to the user. Thus, irrespective of the base station to which the mobile station is associated according to the present invention, as long as the network related information related to said subscriber are identical, the subscriber concerned will receive the same service message throughout the network (the service message being selected based on said network related information related to said subscriber and provided to the service provider).

The Final Office Action admits that Orlen fails to disclose network related information of the subscriber is transmitted in a header of a packet transmitted by the

mobile station of the subscriber and asserts that Parsons makes up for this deficiency.

Parsons discloses a method of servicing data access requests from users. However, it is respectfully submitted that Parsons fails to make up for the deficiencies of Orlen. The Final Office Action alleges that Parsons discloses an IP address of a subscriber is transmitted in a header of a packet transmitted by the subscriber to a network for a security check, citing column 13, lines 34-60 of Parsons. Further, the Final Office Action states that if the subscriber IP address is not correct, service not rendered. However, Parsons discloses that an IP address in a packet header is transmitted for a security check to be conducted at the network entity.

In contrast, according to the present invention, network related information in a header of the packet is transmitted / provided to the service provider. The service provider, however, is distinct from the base station. The network related information as defined in the independent claim 29 is the basis for triggering as well as selecting the service message to the subscriber. It is not used for verifying whether the subscriber's terminal is authorized to receive a service message, but it is used to initiate sending of a thus selected service message to the subscriber's terminal. Apart from the above, it is derivable that the network related information was alleged to correspond to the localized and positional information of a business establishment. In view of this, the suggested modification by the Final Office Action to Orlen cannot work. Namely, in such instance, the localized positional information of the business establishment would have to be transmitted from the mobile station to the

base station to check whether the mobile station is allowed to receive "the same" information back from base station. The service message such as a local advertisement, may correspond to localized positional information as mentioned in Orlen. However, it is clearly distinct from network related information related to a subscriber.

Regarding dependent claims 30, 31, 34, 41-44 and 49-54, The Applicants respectfully submit that Orlen is deficient at least for the same reasons discussed above regarding claims 29 and 48. Dependent claims 30 and 49 which depend from claims 29 and 48 respectively, recites that the network related information relates to at least one of an identity, a location, an address, and an operating state of a mobile station of the subscriber in a cellular network, which is not disclosed or suggested by the cited references taken either individually or in combination. Claim 31 recites the feature wherein the service message is a local advertisement, which is not disclosed or suggested by the cited references taken either individually or in combination. Claim 34 recites the feature wherein said service message is transmitted when said mobile station is reachable according to the network related information which is not disclosed or suggested by the cited references taken either individually or in combination. Claim 41 recites the network related information is inserted by a network element in a second packet which encapsulates the packet transmitted by the mobile station, which is not disclosed or suggested by the cited references taken either individually or in combination. Claim 42 recites the network related information of the subscriber is stored in a storing means in dependence on a predetermined

subscriber condition, and wherein said storage means is accessible to the service provider, which is not disclosed or suggested by the cited references taken either individually or in combination. Claim 43 which depends from claim 42, recites the service provider reads the storing means by using a predetermined key relating to the subscriber, which is not disclosed or suggested by the cited references taken either individually or in combination. Claim 44, which depends from claim 42, recites said predetermined subscriber condition is a request from the subscriber which is not disclosed or suggested by the cited references taken either individually or in combination.

Claim 50, which depends from claim 49, recites a database for converting a cell identification of the mobile station into a location thereof, which is not disclosed or suggested by the cited references taken either individually or in combination. Claim 51 recites the providing means comprises a transmitting means for transmitting the network related information of the subscriber to the service provider, wherein the control means controls the transmitting operation in dependence on the predetermined subscriber condition, which is not disclosed or suggested by the cited references taken either individually or in combination. Claim 52 recites the providing means comprises a storing means in which the network related information of the subscriber is stored and which is accessible to the service provider, wherein the control means controls the storing operation in dependence on the predetermined subscriber condition, which is not disclosed or suggested by the cited references taken either individually or in combination. Claim 53

recites said predetermined subscriber condition is a request from the subscriber, which is not disclosed or suggested by the cited references taken either individually or in combination. Claim 54 recites said predetermined subscriber condition is a subscription parameter of the subscriber which is not disclosed or suggested by the cited references taken either individually or in combination.

In rejecting claims under 35 USC §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. In re Fine, 837 F.2d 1071,1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In doing so, the PTO is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reasons must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S.825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F2d. 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the PTO are an essential part of complying with the burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Further, to establish prima facie obviousness of a claimed invention, all the claimed limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

If the PTO fails to meet this burden, the Applicant is entitled to a patent. In re Glaug, 62 USPQ2d 1151 (Fed. Cir. 2002). In the present case, discussed in detail below, Applicants respectfully submit the PTO has failed to meet this burden.

Applicants respectfully submit that the cited references taken either individually or in combination fail to disclose or suggest all of the features recited in claims 29-31, 34, 41-44 and 48-54 as discussed above. Thus, the Office Action has failed to establish a prima facie case of obviousness against claims 29 and 48 and their respective dependent claims.

Therefore, Applicants are appealing the final rejection of November 17, 2004 and respectfully asserts that the rejection under 35 U.S.C. §103(a) should be withdrawn because the cited references taken either individually or in combination do not teach or suggest each feature of claims 29-31, 34, 41-44 and 48-54.

The Final Office Action rejected claim 32 under 35 U.S.C. 103(a) over Orlen et al. in view of Parsons and further in view of U.S. Patent No. 5,905,777 to Foladare et al. (Foladare). The Final Office Action took the position that Orlen and Parsons disclosed all

of the features recited in claim 32 except the feature that the header message of unread mail stored in a mail server. The Office Action asserted that Foladare disclosed this feature.

Applicants respectfully submit that the cited references taken either individually or in combination, fail to disclose or suggest all of the features recited in claim 32. Specifically, since claim 32 depends from claim 29, Orlen and Parsons are deficient at least for the same reasons discussed regarding claim 29 and Foladare fails to make up for these deficiencies. Claim 32 recites said service message is a header of an unread mail stored in a mail server.

Foladare discloses an e-mail paging system, and is relied upon in the Office Action to disclose a header message of an unread mail stored in a mail server. See column 1, lines 41-55 of Foladare. Thus, Foladare fails to make up for the deficiencies of Orlen and Parsons as discussed above.

It is respectfully submitted that the cited references taken individually or in combination, fail to disclose or suggest all of the features recited in claim 32. Thus, the PTO has not established prima facie obviousness with respect to claim 32. Therefore, the Applicants are appealing the final rejection of November 17, 2004 and respectfully asserts that the rejection under 35 U.S.C. §103(a) should be withdrawn because the cited references taken either individually or in combination do not teach or suggest each feature of claim 32.

The Final Office Action rejected claims 33, 35-38 and 45 under 35 U.S.C. 103(a) as being unpatentable over Orlen in view of Parsons and further in view of U.S. Patent No. 5,555,446 to Jasinski (Janinski). The Final Office Action took the position that Orlen and Parsons disclosed all of the features recited in the above-mentioned claims, except for the features disclosed in Janinski that are discussed below.

Regarding claim 33, the Final Action took the position that Orlen and Parsons disclosed all of the features recited in claim 33, except the feature of wherein the service message is a stock price. The Final Action asserted that Jasinski disclosed this feature.

Applicants respectfully submit that the cited references fail to disclose or suggest all of the features recited in claim 33. Specifically, since claim 33 depends from claim 29, it is respectfully submitted that Orlen and Parsons are deficient at least for the same reasons discussed regarding claim 29 and Jasinski fails to make up for these deficiencies. Claim 33, which depends from claim 29, recites wherein said service message is a stock price change. See column 6, lines 24-26 and 81-87 of Jasinski.

Regarding claims 35-38 and 45, the Final Action took the position that the combination of Orlen and Parsons disclosed all of the features of the above-mentioned claims except the feature that the network information request of the subscriber is transmitted by a network operator to the provider of the external message in dependence on a predetermined subscriber condition. The Final Action asserted that Jasinski disclosed this feature.

It is respectfully submitted that the cited references taken either individually or in combination, fail to disclose or suggest all of the features recited in claims 35-38 and 45. Specifically, since claims 35-38 and 45 depend from claim 29, Orlen and Parsons are deficient at least for the same reasons discussed above regarding claim 29 and Jasinski fails to make up for these deficiencies.

Claim 35 recites the network related information of the subscriber is transmitted by a network operator to the provider of the message in dependence on a predetermined subscriber condition, which is not disclosed or suggested in the cited references. Claim 36 recites wherein said predetermined subscriber condition is a request from the subscriber, which is not disclosed or suggested in the cited references. Claim 37 recites wherein said request is set by the mobile station, which is not disclosed or suggested in the cited references. Claim 38 recites wherein said request is set by a network operator, which is not disclosed or suggested in the cited references. Claim 45 recites said predetermined subscriber condition is a subscription parameter of the subscriber, which is not disclosed or suggested in the cited references.

Applicants respectfully submit that claims 33, 35-38 and 45 recite features that are not disclosed or suggested in the cited references, taken either individually or in combination. Thus, the PTO has not established prima facie obviousness with respect to claims 33, 35-38 and 45. Therefore, the Applicants are appealing the final rejection of November 17, 2004 and respectfully asserts that the rejection under 35 U.S.C. §103(a)

should be withdrawn because the cited references taken either individually or in combination do not teach or suggest each feature of claims 33, 35-38 and 45.

The Final Action rejected claim 39 under 35 U.S.C. 103(a) as being unpatentable over Orlen in view of Parsons and Jasinski and further in view of U.S. Patent No. 6,141,558 to Chen (Chen). The Office Action took the position that Orlen and Parsons disclosed all of the features recited in claim 39, except the feature of a network operator receives the request including a service provider address, retrieves location coordinates of the subscriber and transmits the location to the service provider using the received address. The Final Action asserted that Chen disclosed this feature.

Applicants respectfully submit that the cited references taken either individually or in combination fail to disclose or suggest all of the features recited in claim 39. Specifically, since claim 39 depends from claim 29, Orlen and Parsons are deficient at least for the same reasons discussed above regarding claim 29 and Chen fails to make up for these deficiencies. Claim 39 recites wherein a network operator receives the request including a service provider address, retrieves location coordinates of the subscriber on the basis of a cell identification, and transmits the location coordinates to the service provider using the received address.

Chen discloses a method and apparatus for locating a subscriber unit in a communication system. Chen is relied upon in the Office Action to teach that a network operator receives the request including a service provider address, retrieves location

coordinates of a subscriber and transmits the location to the service provider using the received address. See Chen column 3 line 64 – column 4 line 9.

Applicants respectfully submit that the cited references taken individually or in combination fail to disclose or suggest all of the features recited in claim 39. Thus, the PTO has not established prima facie obviousness with respect to claim 39. Therefore, the Applicants are appealing the final rejection of November 17, 2004 and respectfully asserts that the rejection under 35 U.S.C. §103(a) should be withdrawn because the cited references taken either individually or in combination do not teach or suggest each feature of claim 39.

The Final Office Action rejected claims 46 and 47 under 35 U.S.C. 103(a) as being unpatentable over Orlen in view of Parsons and Jasinski, and further in view of WO 98/21913 to Bhatia (Bhatia). The Final Action took the position that Orlen, Parsons and Jasinski disclosed all of the features of claims 46 and 47, except the feature of an activation of a predetermined supplementary service and the subscriber is located in his home area. The Final Action asserts that Bhatia disclosed this feature.

Applicants respectfully submit that the cited references taken either individually or in combination, fail to disclose or suggest all of the features recited in claims 46 and 47. Specifically, since claims 46 and 47 depend from claim 35, which in turn depends from claim 29, Orlen, Parsons and Jasinski are deficient at least for the same reasons discussed above regarding claim 35 and Bhatia fails to make up for these deficiencies.

Claim 46 recites said predetermined subscriber condition is an activation of a predetermined supplementary service. Claim 47 recites said predetermined subscriber condition is the fact that the subscriber is located in his home area.

Bhatia discloses that a predetermined supplementary service and a subscriber is located in the home area. See page 3, lines 9-24 and page 3, lines 25-29, and page 4 lines 19-30 of Bhatia. However, Bhatia fails to make up for the deficiencies of Orlen, Parsons and Jasinski as discussed above.

Therefore, Applicants respectfully submit that the cited references taken either individually or in combination fail to disclose or suggest all of the features recited in claims 46 and 47. Thus, the PTO has not established prima facie obviousness with respect to claims 46 and 47. Therefore, the Applicants are appealing the final rejection of November 17, 2004 and respectfully asserts that the rejection under 35 U.S.C. §103(a) should be withdrawn because the cited references taken either individually or in combination do not teach or suggest each feature of claims 46 and 47.

The Office Action rejected claims 55 and 56 under 35 U.S.C. 103(a) as being unpatentable over Orlen in view of Parsons and further in view of Bhatia. The Office Action took the position that Orlen and Parsons disclosed all of the features recited in claims 55 and 56, except the feature of an activation of a predetermined supplementary service and the subscriber is located in his home area. The Final Action asserted that Bhatia disclosed this feature.

Applicants respectfully submit that the cited references taken either individually or in combination do not disclose or suggest all of the features recited in claims 55 and 56. Specifically, it is respectfully submitted that since claims 55 and 56 depend from claim 48, Orlen and Parsons are deficient at least for the same reasons discussed regarding claim 48 and Bhatia fails to make up for these deficiencies.

Claim 55 recites said predetermined subscriber condition is an activation of a predetermined supplementary service. Claim 56 recites said predetermined subscriber condition is the fact that the subscriber is located in his home area.

Bhatia discloses that a predetermined supplementary service and a subscriber is located in the home area. See page 3, lines 9-24 and page 3, lines 25-29, and page 4 lines 19-30 of Bhatia. However, Bhatia fails to make up for the deficiencies of Orlen and Parsons as discussed above.

Applicants respectfully submit that the cited references taken either individually or in combination, fail to disclose or suggest all of the features recited in claims 55 and 56. Thus, the PTO has not established prima facie obviousness with respect to claims 55 and 56. Therefore, the Applicants are appealing the final rejection of November 17, 2004 and respectfully asserts that the rejection under 35 U.S.C. §103(a) should be withdrawn because the cited references taken either individually or in combination do not teach or suggest each feature of claims 55 and 56.

Due to the significant deficiencies in the cited references which are discussed above,

it is respectfully submitted that that the cited references taken either individually or in combination cannot be interpreted as teaching all of the elements of the current invention. It is therefore respectfully requested that each of claims 29-39 and 41-56 be found to contain allowable subject matter.

As discussed above the cited references individually or in combination fail to disclose or suggest at least the features of presenting network related information which related to the subscriber, or the feature of providing network related information to a service provider, as recited in the pending claims.

X. CONCLUSION

For all of the above noted reasons, it is strongly submitted that certain clear differences exist between the present invention as claimed in claims 29-39 and 41-56 and the prior art relied upon by the PTO. This final rejection being in error, therefore, it is respectfully requested that this Honorable Board of Patent Appeals and Interferences reverse the Examiner's decision in this case regarding the rejection of claims 29-39 and 41-56 and indicate the allowability of all of pending claims 29-39 and 41-56.

In the event that this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees which may be due with respect to this paper may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

SQUIRE, SANDERS & DEMPSEY LLP

A handwritten signature in black ink, appearing to read 'D.E. Brown', with a stylized flourish at the end.

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APPENDIX 1

CLAIMS ON APPEAL

Claims 1-28. (Canceled)

29. A method for providing a service to a subscriber in a network, comprising the steps of:

providing a network related information which is related to said subscriber;

generating a service message on the basis of said provided network related information; and

transmitting said service message to said subscriber,

wherein

said network related information is provided for a service provider; ~~and~~

said service message is a message generated by said service provider,

said service message is transmitted to all those subscribers for which the same network related information is provided to the service provider; and

the network related information of the subscriber is transmitted in a header of a packet transmitted by the mobile station of the subscriber.

30. A method according to claim 29, wherein

said network related information relates to at least one of an identity, a location, an address, and an operating state of a mobile station of the subscriber in a cellular network.

31. A method according to claim 29, wherein said service message is a local advertisement.

32. A method according to claim 29, wherein said service message is a header of an unread mail stored in a mail server.

33. A method according to claim 29, wherein said service message is a stock price change.

34. A method according to claim 30, wherein said service message is transmitted when said mobile station is reachable according to the network related information.

35. A method according to claim 30, wherein the network related information of the subscriber is transmitted by a network operator to the provider of the message in dependence on a predetermined subscriber condition.

36. A method according to claim 35, wherein said predetermined subscriber condition is a request from the subscriber.

37. A method according to claim 36, wherein said request is set by the mobile station.

38. A method according to claim 36, wherein said request is set by a network operator.

39. A method according to claim 36, wherein a network operator receives the request including a service provider address, retrieves location coordinates of the subscriber on the basis of a cell identification, and transmits the location coordinates to the service provider using the received address.

40. (Cancelled)

41. A method according to claim [[40]] 29, wherein
the network related information is inserted by a network element in a second packet which encapsulates the packet transmitted by the mobile station.

42. A method according to claim 29, wherein
the network related information of the subscriber is stored in a storing means in dependence on a predetermined subscriber condition, and wherein said storage means is accessible to the service provider.

43. A method according to claim 42, wherein
the service provider reads the storing means by using a predetermined key relating to the subscriber.

44. A method according to claim 42, wherein
said predetermined subscriber condition is a request from the subscriber.

45. A method according to claim 35, wherein
said predetermined subscriber condition is a subscription parameter of the subscriber.

46. A method according to claim 35, wherein
said predetermined subscriber condition is an activation of a predetermined supplementary service.

47. A method according to claim 35, wherein
said predetermined subscriber condition is the fact that the subscriber is located in
his home area.

48. A system for providing a service to a subscriber in a network, comprising:
providing means for providing a network related information which is related
to said subscriber; and
control means for controlling the provision of said network related
information in dependence on a predetermined subscriber condition,
wherein
said providing means is arranged to provide said network related information
for a service provider connected to said network; and
said service provider is arranged to generate a message on the basis of said
network related information, said message being transmitted to said subscriber,
wherein
said service message is transmitted to all those subscribers for which the
same network related information is provided to the service provider; and
the network related information of the subscriber is transmitted in a header of
a packet transmitted by the mobile station of the subscriber.

49. A system according to claim 48, wherein
the network related information relates to at least one of an identity, a location and
an operating state of a mobile station of the subscriber in a cellular network.

50. A system according to claim 49, ~~wherein~~ comprising
a ~~data-base~~ database for converting a cell identification of the mobile station into a
location thereof.

51. A system according to claim 48, wherein
the providing means comprises a transmitting means for transmitting the network
related information of the subscriber to the service provider, wherein the control means
controls the transmitting operation in dependence on the predetermined subscriber
condition.

52. A system according to claim 48, wherein
the providing means comprises a storing means in which the network related
information of the subscriber is stored and which is accessible to the service provider,
wherein the control means controls the storing operation in dependence on the
predetermined subscriber condition.

53. A system according to claim 48, wherein

said predetermined subscriber condition is a request from the subscriber.

54. A system according to claim 48, wherein

said predetermined subscriber condition is a subscription parameter of the subscriber.

55. A system according to claim 48, wherein

said predetermined subscriber condition is an activation of a predetermined supplementary service.

56. A system according to claim 48, wherein

said predetermined subscriber condition is the fact that the subscriber is located in his home area.